

REMARKS

Elected Claims 1, 3, 8-17, 24, 25, 28-31, 33, new independent Claim 35, its dependent Claims 36-37, new independent Claim 38, and its dependent Claims 39-40 are pending in this application. Claims 2, 5-7, 20, 26-27, 33 and 34 have been canceled without prejudice. The non-elected Claims 4, 18, 19 and 21-23 are withdrawn.

Claims 1, 8, 16 and 24 have been amended to further clarify the invention. Support for the clarifying amendment to the conditioner in Claim 1 is found in Claim 2, now canceled, in the text in paragraph [0022] of the Pre-Grant published application, US2008/0229512, and elsewhere throughout the text and examples. No new matter is added by these Amendments. Support for new Claims 35-37 and for new Claims 38-40 is found in paragraph [0028] and [0031] and elsewhere in the text of the Pre-Grant published application and in the disclosures of the self-emulsifying fatty acid-derived conditioner (SFC) portion of the composition in Example 1, Tables 1, and Table 2. No new matter is introduced by new Claims 35-40, which are directed to the elected species.

The rejections under 35 U.S.C. 112, second paragraph

Claims 1-3, 8-17, 24, 25, 28-31, and 33 stand rejected under 35 U.S.C. second paragraph for alleged indefiniteness by the use of the relative term, “substantially” in conjunction with “immediately” in claims 1 and 24 and by the recitation of “... at least about...” in claims 16 and 24. Applicants respectfully submit that the joint use of the terms “substantially immediately” is not indefinite as Applicants have defined this time frame in the first sentence of paragraph [0043] of the Pre-Grant published application, US2008/0229512. In the interest of expediting prosecution, however, this rejection has been rendered moot by the record clarifying amendments to Claims 1, 16, and 24 and should be withdrawn as to all the pending claims as presented of record.

The rejections under 35 U.S. C. §102

Claims 1 and 9 stand rejected under 35 U.S. C. 102(b) as allegedly being anticipated by Lorenz *et al.* (US Patent 5,989,530). Applicants traverse the rejection in part by the amendments to Claim 1, and by the following remarks.

Claim 1 is neither anticipated by, nor obvious over, Lorenz *et al.* Claim 1 is directed to a substantially anhydrous, free-flowing composition comprising a water-dispersible, self-emulsifying, fatty acid-derived conditioner which is a combination of materials, defined by

the elected species recited therein (i.e., selected from the group consisting of a fatty ester, an ethoxylated glyceride, a fatty alcohol, and a fatty ether, and optionally including at least one hydrophilic surfactant). Furthermore, Claim 1 has been amended for further clarity of the water-dispersible, fatty-acid derived conditioner combination.

The combination of the claimed self-emulsifying, fatty acid-derived conditioner is physically present as an ingredient in the free-flowing composition (referred to as the "SFC" portion of the formulation in Table 1, for example). The prior art does not teach Applicants' claimed combination or that the separately known materials are self-emulsifying when combined, in the absence of Applicants' teaching. When the free-flowing composition of the present invention is later admixed for use with an aqueous medium, a conditioning hair lightener emulsion surprisingly forms substantially immediately (i.e., within 5 minutes as defined in paragraph [0043] of the Pre-Grant published application US2008/0229512) with minimal manual mixing agitation (see paragraph [0043] of the published application). The resulting so-formed hair lightener emulsion surprisingly beneficially ameliorates one or more deleterious effect on the tensile and tactile properties of hair oxidatively lightened under relatively high alkaline conditions, even when no hair protectant, deswelling agent is present (See Examples 5-7).

The Office Action asserts with regard to Claim 1 that:

"Lorenz et al. disclose a free-flowing powdery (anhydrous) composition that contains vegetable oils (water-dispersible; self-emulsifying fatty acid-derived conditioners)....".

...

"Lorenz et al. disclose mixing the composition with a solution of hydrogen peroxide (an aqueous medium) and applying the mixture to the hair (column 2, line 27-33). Though Lorenz et al. do not identify this mixture as an emulsion, the conclusion that it is an emulsion is inescapable since water, oil (self-emulsifying no less), and an emulsifying surfactant are present in the mixture."

Contrary to the statements in the Office Action regarding Claim 1, vegetable oils, *per se*, are not self-emulsifying. It is commonly well known, even to a lay person, that oils and water do not mix. The dogmatic assertion of oil is self-emulsifying is unsupported by any reference and if the Examiner is aware of any reference that states that oils are self-emulsifying, Applicants respectfully request that it be made of record.

Lorenz *et al.* focus on controlling the dusting of conventional bleaching powders and resolve this problem by spraying oils and liquid waxes onto its powder base for controlling the dusting (col. 1, lines 16-18; and Examples 1-2). The oils are not emulsified nor is there any teaching of emulsifying the oils at all. The low quantities of ethoxylated non-ionic surfactant disclosed also is for further improving dust control (col. 1, lines 60-67; and Example 3). Lorenz *et al.* do not teach the combination defined and claimed by Applicants as the self-emulsifying, fatty acid-derived conditioner in its composition.

The Examiner correctly noted that Lorenz *et al.* do not identify the mixture of its composition with a solution of hydrogen peroxide as an emulsion, because there is no teaching or suggestion or discussion in Lorenz *et al.* of emulsification or the formation of an emulsion, let alone self-emulsification. Lorenz *et al.* simply describe the mixture of the dust-free powder and hydrogen peroxide solution. (See Examples 1-3) as a blend. Thus, the assertion in the office action that “an emulsion is inescapable” is erroneous and unsupported.

In essence, the Examiner’s argument amounts to an assertion that self-emulsification is *de facto* inherent in the disclosures of Lorenz *et al.* However, inherency requires that the prior art product necessarily includes all the limitations. “In relying upon a theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied art.” Ex parte Levy, 17 USPQ2d 1461, 1464 (BPAI 1990) (emphasis in original). See also M.P.E.P. 2112, Section IV.

Inherency may not be established by probabilities or possibilities. In re Oelrich, 212 USPQ 323, 326 (CCPA 1981), cited recently for this proposition in Ex parte Whalen, 89 USPQ2d 1078, 1083 (BPAI 2008) in reversing an examiner's rejection. The mere possibility or probability that the missing limitation is present is not sufficient to establish a *prima facie* case. See Ex parte Skinner, 2 USPQ2d 1788 (BPAI 1986); Continental Can co. v. Monsanto Co., 20 USPQ2d 1746, 1749 (Fed. Cir. 1991); and In re Robinson, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). The burden is on the Examiner to provide evidence or technical reasoning tending to show that the missing limitation is necessarily present (i.e., will always be present, not just may be present) and that burden clearly has not been met here. In particular, the Examiner has not established that Lorenz *et al.* necessarily discloses the self-emulsifying, fatty acid-derived conditioner.

There is no teaching or suggestion in Lorenz *et al.* of any conditioner or emulsion, let alone a combination of conditioners, or a conditioning emulsion. The Examiner admits that Lorenz *et al.* do not expressly teach the claimed combination of hair conditioners. There is nothing in Lorenz *et al.*, therefore, that discloses all the limitations of Applicants' invention, combined in the same way as recited in the claims. The Circuit Court of Appeals of the Federal Circuit has long held "...that unless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed, and, thus, cannot anticipate under 35 U.S.C. §102." See, most recently, Net MoneyIN Inc. v. VeriSign, Inc., 88 USPQ2d 1751, 1759 (Fed. Cir. 2008), and prior cases cited therein.

Accordingly, Lorenz *et al.* do not, and cannot, anticipate (or render obvious) the present conditioning hair lightener composition as presented in the claims now of record, under 35 U.S.C. 102. The rejection should be withdrawn.

The rejections under 35 U.S.C. § 103(a)

Claims 1-3 and 8 stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Lorenz *et al.* (US Patent 5,989,530) in view of Cincotta *et al.* (Pre-Grant Publication US2002/0155962). Applicants traverse this rejection in part by the amendment to the claims, the discussion above regarding Lorenz *et al.*, repeated herein by reference, and the following remarks.

The Examiner admits that: "The difference between Lorenz *et al.* and the instant claims is that Lorenz *et al.* do not expressly teach the claimed combination of hair conditioners." but incorrectly states that: "This deficiency in Lorenz *et al.* is cured by the teachings of Cincotta *et al.*". In supporting the rejection, the Examiner states:

"Cincotta *et al.* teach, as a whole, a non-aqueous (hence substantially anhydrous) composition to style hair which contains many hair conditioners (fixative, humectants, emollients, etc.)"

...

"The skilled artisan would have been motivated to combine these teachings because both Lorenz, *et al.*, and Cincotta, *et al.*, teach anhydrous hair care compositions, one for bleaching and one for styling; therefore, the integration of their teachings to create one anhydrous composition capable of both bleaching and styling would have been obvious to the skilled artisan."

Contrary to the Examiner's assertions, there is no teaching or suggestion in Cincotta *et al.* of powder compositions of any kind or of a "hair active composition" or of concurrently conditioning the hair during any chemically reactive (i.e., hair active) treatment, e.g., bleaching. Cincotta *et al.* focus only on the problem of physically styling the hair and holding a hair style in place by topically applied compositions of vinyl copolymers in non-aqueous solvent. The composition of Cincotta *et al.*, therefore, is not chemically reactive and, the Examiner's assertion that is a "hair active composition" is erroneous. The composition is a non-reactive liquid hair styling composition that can be applied on all types of hair, including hair that has been previously treated with chemically reactive compositions, and is left on the hair.

Persons skilled in the hair styling and chemical hair treatment arts understand that bleaching and styling of hair are discreetly different treatments. Hair bleaching requires an aqueous composition for effectiveness, whereas holding the properties of a hair style is negatively affected by aqueous mediums. As such, it is not common to combine these treatments into a single composition. Cincotta *et al.* teach non-aqueous hair styling compositions to overcome the negative problems associated with aqueous hair styling compositions (see paragraph [0015] of the Pre-Grant published application US2002/0155962. Hence, Cincotta *et al.* teach away from using aqueous compositions, there is no suggestion or motivation to admix the composition of Cincotta *et al.* with an aqueous medium at all and to do so would negate the hair styling purpose of Cincotta *et al.* There is no logical reason or motivation found in Lorenz *et al.* and Cincotta *et al.* to "integrate" their teachings as proposed by the Examiner.

As stated previously, there is no teaching in Lorenz *et al.* of conditioning the hair at all and hence no motivation to concurrently condition and bleach the hair. Likewise, there is no teaching or suggestion in Cincotta *et al.* of powder products, much less of powder bleaches, or of concurrently conditioning and bleaching the hair. That Cincotta *et al.* teaches many individually known hair conditioners, therefore, does not and cannot render obvious Applicants' claimed combination of hair conditioners in its conditioning hair lightener powder, taken alone or in combination with Lorenz *et al.*

The mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole, and the Examiner has failed to explain the reason why one of ordinary skill in the art would have been motivated to select the references

and to combine them to render the claimed invention obvious, as required. In re Kahn, 78 USPQ2d 1329, 1355, 1357-59 (Fed. Cir. 2006). Applicants submit that the Examiner is selectively combining the disclosures of the prior art by improperly using the benefit of hindsight to reconstruct the Applicants' invention from the Applicants' own teachings. It is impermissible hindsight to combine pieces of the prior art to argue that a combination invention is obvious. There must be something in the prior art that suggested the combination other than the hindsight gained from knowing that the inventor chose to combine these particular things in this particular way. Uniroyal, Inc. v. Rudkin-Wiley Corp., 5 USPQ2d 1434, 1438 (Fed. 1988).

It is well established that each prior art reference must be evaluated in its entirety and that all of the prior art must be evaluated as a whole. As stated by the CCPA: "It is impermissible to first ascertain factually what appellants *did* and then view the prior art in such a manner as to select from the random facts of that art only those which may be modified and then utilized to reconstruct appellants' invention." [emphasis in original] In re Shuman, 150 USPQ 54, 57 (CCPA 1996) quoted in Panduit Corp. v. Dennison Manufacturing Co., 227 USPQ 337, 342-43 (Fed. Cir. 1985).

A *prima facie* case for obviousness requires that the asserted combination of references teaches or suggests all of the limitations of the rejected claims. Here Applicants respectfully submit that neither Lorenz et al. nor Cincotta et al., alone or in combination, render obvious Applicants' claimed combination. As the CAFC stated in In re Graviak, 226 USPQ 870, 872 (Fed. Cir. 1998) citing In re Bergel, 130 USPQ 206, 208 (CCPA 1961):

"The mere fact that it is possible to find two isolated disclosures which might be combined in such a way to produce a new compound does not necessarily render such production obvious unless the art also contains something to suggest the desirability of the proposed combination."

Here, there is nothing in the art suggesting the desirability of the claimed combination in the pending claims or record, or suggesting the motivation to do so. See Application of Imperato, 179 USPQ 730 (CCPA 1973) cited by the CAFC for the same proposition in In re Sernaker, 217 USPQ 1 (Fed. Cir. 1983) and also In re Gordon, 221 USPQ 1125 (Fed. Cir. 1984). Applicants submit that the Examiner has failed to establish a *prima facie* case of obviousness and the art-based rejection of the pending claims 1, 3 and 8, as presented of record, should be withdrawn.

Claims 1, 10-17, 24, 25, 28-31, and 33 stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Lorenz *et al.* (discussed above) in view of Syed *et al.* (U.S. Patent No. 5,756,077). Applicants traverse this rejection in part by the amendment to the claims, the previous discussions above regarding Lorenz *et al.*, repeated herein by reference, and the following remarks.

With regard to Claim 16 and Claim 24, the Office Action states:

“Lorenz, et al., disclose a free-flowing powdery (anhydrous) composition that contains vegetable oils (water-dispersible, self-emulsifying fatty acid-derived conditioners) and peroxide salts (Column 1, line 46 through Column 2, line 11, See Claim 1 in 102 Section), which is Component (A) of the claim. Lorenz, et al., disclose a solution of hydrogen peroxide (an aqueous medium, Component (B) of the claim) which is mixed with the anhydrous free-flowing composition to form an emulsion (Column 2, line 27-33).”

Applicants have previously shown, and repeat here by reference, that Lorenz *et al.* do not teach or suggest conditioners, or the combination of self-emulsifying conditioners claimed by Applicants, and do not teach emulsions, or emulsification. The mixture of Lorenz *et al.*, as stated in the Examples 1-3 is described as a “blend”, so the Examiner’s assertion that an emulsion is formed is unsupported

The Examiner admits that: “The difference between Lorenz, et al., and the instant claims is that Lorenz, et al., do not expressly teach the claimed hair protectants, additional system components, or kit.”, but incorrectly states that: “This deficiency in Lorenz, et al., is cured by the teachings of Syed, et al.” Although the Examiner correctly states that: “Syed, et al., teach, as a whole, a method for protecting chemically treated hair and a kit for using the compositions to protect hair.”, Syed *et al.* do not teach or suggest powder compositions, much less bleaching powders. The compositions of Syed *et al.* are aqueous liquids.

Additionally, the compositions of Syed *et al.* are applied to previously damaged hair to protect the previously damaged hair by blocking the action of a subsequent treatment with the same chemical treatment. In Applicants’ claimed conditioning hair lightener powder, the hair protectant ingredient is an optional, auxiliary ingredient, and not an essential ingredient as in the composition of Syed *et al.* In contrast to Syed *et al.*, when a hair protectant is present in Applicants’ claimed composition, it is concurrently present during the chemical treatment (i.e., bleaching). There is no teaching, or suggestion, or motivation in Syed *et al.* to prepare a powder

conditioning hair lightener or of the claimed combination of water dispersible, self-emulsifying fatty-acid derived conditioners therein, taken alone or with Lorenz *et al.* Thus that Syed *et al.* teach selective individual components recited in Claims 10, 11-13, 14-15, 16, 17, 14, 15, 28-29, 30, 31 and 33, as set out by the Examiner, does not render the Applicants' claimed invention as a whole obvious either alone or in combination with Lorenz *et al.*

Applicants submit that the Examiner is selectively picking and choosing isolated disclosures from the prior art using the benefit of hindsight. While a reference can be utilized for all that it teaches, focusing upon isolated portions of the reference or picking and choosing only that which supports a holding of obviousness is improper. In re Wesslau, 147 USPQ 391, 393 (CCPA 1965); Panduit Corp. v. Dennison Mfg. Co., 1 USPQ2d 1593, 1602 (Fed. Cir. 1987). The claimed invention must be considered as a whole; it is irrelevant to determining obviousness that some or all aspects of the claim may have been otherwise known in the art. Jones v. Hardy, 220 USPQ 1021, 1024 (Fed. Cir. 1984). References that merely indicate that isolated features recited in the claims are known in the art do not provide a sufficient basis for concluding that the rejected combination of claim elements would have been obvious. Ex parte Hiyamizu, 10 USPQ2d 1393, 1394 (BPAI 1988), absent evidence of a motivating force which would impel a person of skill in the art to do what Applicant has done. Ex parte Levengood, 28 USPQ2d 1300, 1301 (BPAI 1993). The references viewed by themselves, and not in retrospect, must suggest doing what the Applicant has done. In re Schaffer, 108 USPQ 326, 328-9 (CCPA 1956).

The Examiner has failed to make a proper *prima facie* case in support of the asserted ground for rejection. The asserted references, taken alone or in combination, do not teach each and every limitation of the claimed invention. The asserted art do not suggest or teach any motivation within themselves, to make the modification and combination of art as asserted by the Examiner to arrive at the claimed invention. The Examiner's motivation to combine the asserted art and the asserted rationale for this rejection could only have come from an improper use of hindsight to construct the claimed inventions. This rejection of Claims 1, 10-17, 24, 25, 28-31 and 33, as presented of record, must be withdrawn.

In conclusion, Applicants submit that the prior art does not teach or suggest Applicants' combination of water-dispersible, self-emulsifying, fatty-acid derived conditioners in Applicants' substantially anhydrous, free-flowing composition as set forth in the pending claims. The prior art does not teach or suggest Applicants' specific combination of conditioner materials or that such a combination is self-emulsifying as set forth in the pending claims. Claims 1, 3, 8-17, 24-25, 28-31, and 39-40 as presented of record are believed to be in condition for allowance.

Applicants respectfully request an early and favorable action on the merits with respect to all of the claims.

Respectfully submitted,

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By 
Dolores T. Kenney (Reg. No. 31,269)

CUSTOMER NO.: 002387

OLSON & CEPURITIS, LTD.

20 North Wacker Drive

36th Floor

Chicago, Illinois 60606

(312) 580-1180